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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,364	12/30/2003	Kenneth A. Walker JR.	03-010	7796

37420 7590 09/27/2007  
VISTA PRINT USA, INC.  
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EXAMINER
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JONES, HUGH M

ART UNIT	PAPER NUMBER
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2128

MAIL DATE	DELIVERY MODE
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09/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/748,364

Applicant(s)

WALKER ET AL.

Examiner

Hugh Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5, 6, 8-21, 23, 24 and 26-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 8-21, 23, 24 and 26-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

1. Claims 1-3,5,6,8-21,23,24 and 26-36 of U. S. Application 10/748,364, filed 12/30/2003, are pending.

#### **Claim Rejections - 35 USC § 103**

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-3,5,6,8-21,23,24 and 26-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over von Kaenel in view of Applicant's Own Admission.

5. Von Kaenal et al. disclose incorporating maps into designs as discussed subsequently.

6. Von Kaenal et al. do not appear to disclose printing by the vendor.

7. AOA teaches the feature.

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8. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Von Kaenal et al. with AOA because AOA discloses the advantages of using an external print service. See paragraphs 2-3 of the application (background of the art).

9. Von Kaenal et al. disclose:

making electronic map information available to a server computer system, the map information containing information covering a relatively large geographical area and being adapted to produce relatively high resolution maps (fig. 13, 21, 25),

in response to information received from a client computer system identifying a location within the relatively large geographical area, obtaining a relatively high resolution user map from the map information, the user map covering a relatively small geographical area that includes at least the identified location (fig. 13, 21, 25, 109, 110, 136, 166),

generating a lower resolution display map version of the user map, the display map being suitable for displaying at the client (col. 65, lines 19-67; screen vs print size),

transmitting the display map to the client for displaying to the user (fig. 13, 21, 25),

receiving a description of an electronic product design from the client, the description identifying at least a portion of the display map (fig. 13, 21, 25, 30-31, 33),

associating the identified portion of the display map with corresponding map information such that the product design will be printed using the higher resolution version of the display map (fig. 13, 21, 25, 30-31, 33),

further comprising storing the obtained user map is stored at the server (fig. 13, 21, 25),

further comprising storing the display version at the server (fig. 13, 21, 25),

further comprising retrieving the stored display version in response to a request from the user and transmitting the display version to the client computer system (fig. 13, 21, 25),

further comprising generating a thumbnail version of the display map and storing the thumbnail version at the server (fig. 13, 21, 25; screen vs print size),

further comprising retrieving the stored thumbnail version in response to a request from the user and transmitting the thumbnail version to the client computer system for viewing by the user (fig. 13, 21, 25; screen vs print size),

wherein the user map is based on location information supplied by the user for the purpose of obtaining a map (fig. 13, 21, 25),

wherein the user map is based on location information extracted from information previously supplied by the user for another purpose (fig. 13, 21, 25; col. 61, lines 8-23),

wherein the information received includes a zoom level to be used to obtain the user map (fig. 13, 21, 25, 92),

wherein the electronic product design has a defined map area and wherein the user map is obtained from the map information at a height and width ratio that corresponds to the height to width ratio of the map area in the electronic product design (fig. 13, 21, 25; col. 65, lines 19-67),

wherein the electronic product design has a defined map area and wherein the

display map is generated to have a height and width ratio that corresponds to the height to width ratio of the available map area in the electronic product design (fig. 13, 21, 25).

10. Von Kaenal et al. does not appear to disclose printing on two sides, as recited, for example, in amended claim 1:

providing an image of at least a portion of a first side of the product for displaying to the user of a client computer for customization by the user,  
providing a tool allowing the user to supply at least text to be printed on the first side,  
providing an image of at least a portion of a second side of the product for displaying to the user for customization by the user, the second side of the product having a map area where a map will be printed when the product is printed,  
providing a tool allowing the user to identify a location to be included within the map that will be printed in the map area,

11. Applicants have admitted that it was known to edit various types of common print materials offline and that the editing tools were available.

[0002] Many individuals, businesses, and organizations occasionally have a need for custom printed materials, such as business cards, party invitations, product or service brochures, promotional postcards, or any number of other items. Some of these individuals and businesses turn to sources such as a local print shop for assistance in preparing the materials. Others may attempt to create the product themselves using specialized software purchased and installed on a personal computer to design the product and using their local printer attached to their personal computer to perform the printing.

12. A skilled artisan would recognize that the materials commonly include two sides, since there are usually two sides available for printing, and would recognize the advantages in printing on both sides including, for example, the ability to provide more information to a customer through one piece of printed material.

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13. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Von Kaenal et al. teaching to include editing/printing on both sides in the context of the Internet.

14. As noted by the Court, when there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103. *KSR Int'l v. Teleflex, Inc.*, 550 U.S. \_\_\_\_ (2007).

15. "In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. **What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under §103.** One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims." *KSR Int'l v. Teleflex, Inc.*, 550 U.S. \_\_\_\_ (2007).

16. Applicants have admitted that there is a known problem, namely the need for custom printed materials, and that it is known and desirable to do so with various editing tools, without the internet:

[0002] Many individuals, businesses, and organizations occasionally have a need for custom printed materials, such as business cards, party invitations, product or service brochures, promotional postcards, or any number of other items. Some of these individuals and businesses turn to sources such as a local print shop for assistance in preparing the materials. Others may attempt to create the product themselves using specialized software purchased and installed on a personal computer to design the product and using their local printer attached to their personal computer to perform the printing.

17. Applicants have admitted that it is known and desirable to do so on the internet with various editing tools.

[0003] An increasingly popular alternative for obtaining these types of materials is the use of a Web-based printing service provider that takes advantage of the capabilities of the Web and modern Web browsers to provide document design services from any computer with Web access at whatever time and place is convenient to the user. Computerized systems typically provide their customers with the ability to access and view a wide range of pre-designed product templates, select a desired template, and enter information to create a customized product design. Typically, a user can add, modify, and position custom text and upload images to be added to the electronic product design. When a user is satisfied with the design of the product, the user can place an order with the printing service provider for the production of a desired quantity of high quality printed versions of the product to be delivered to the customer's home or business.

[0004] In another computer-related field, high quality mapping software is available from various vendors either online or on a CD or other media and mapping software applications have become common. Examples include mobile applications, like handheld and automotive map systems using global positioning technology, and commercial establishment applications, such as customized driving maps printed at car rental offices for individual customers. In the Web environment, various free services available on the Web, such as MapQuest.com and Yahoo.com, allow an individual to enter a street address and view a corresponding map. Tools to modify the displayed map by zooming or scrolling are also commonly provided. Businesses maintaining Web sites frequently incorporate access to a mapping service to display maps for stores and custom driving directions from an address entered by the user.



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It would have been obvious to one of ordinary skill in the art at the time of the invention to practice the claimed invention.

18. In *Kahn*, the court affirmed the PTO's finding of obviousness, explaining at great length that a "teaching, suggestion, or motivation" can be found "implicitly" based on precisely the factors that the Solicitor General says are relevant: "*what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.*" 441 F.3d 987

19. In *Dystar Textilfarben v. C.H. Patrick* (06-1088), the court explained, "an implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the 'improvement' is technology-independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient." (emphasis added). In this case, the "problem" facing those in the art, and the solution was known:

[0003] An increasingly popular alternative for obtaining these types of materials is the use of a Web-based printing service provider that takes advantage of the capabilities of the Web and modern Web browsers to provide document design services from any computer with Web access at whatever time and place is convenient to the user.

Computerized systems typically provide their customers with the ability to access and view a wide range of pre-designed product templates, select a desired template, and enter information to create a customized product design. Typically, a user can add, modify, and position custom text and upload images to be added to the electronic product design.

When a user is satisfied with the design of the product, the user can place an order with the printing service provider for the production of a desired quantity of high quality printed versions of the product to be delivered to the customer's home or business.

**Response to Arguments**

20. Applicant's arguments, filed 7/12/2007, have been carefully considered but are not persuasive.

21. Applicants argue:

The von Kaenel reference discloses a system for storing and retrieving spatial data, including map images. For example, as generally depicted in Fig. 13 and described at col. 27, line 27 to col. 28, line 2, a user can submit a request to a server to view selected information, which will typically be returned by the server as a number of image layers that are combined into a single image at the client computer. As depicted in Fig. 23 and described at col. 44, line 48 to col. 45, line 6, the von Kaenel reference describes allowing the user to print a copy of a displayed image. The von Kaenel server creates the printable file and sends it to the user's computer for local printing by the user.

and

The claims of the pending application have been amended to clarify that the claimed methods and systems are not directed to merely generating and viewing an online map image and then printing a copy of it, but rather to methods and systems for allowing a user to perform online design of a customized, two-sided product to be printed, the overall product design having as one component a user-customizable map area.

22. However, Applicants have admitted in the specification that there is a known problem, namely the need for custom printed materials:

[0002] Many individuals, businesses, and organizations occasionally have a need for custom printed materials, such as business cards, party invitations, product or service brochures, promotional postcards, or any number of other items. Some of these individuals and businesses turn to sources such as a local print shop for assistance in preparing the materials. Others may attempt to create the product themselves using specialized software purchased and installed on a personal computer to design the product and using their local printer attached to their personal computer to perform the printing.

and that it is known to do so on the internet with various editing tools.

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[0003] An increasingly popular alternative for obtaining these types of materials is the use of a Web-based printing service provider that takes advantage of the capabilities of the Web and modern Web browsers to provide document design services from any computer with Web access at whatever time and place is convenient to the user.

Computerized systems typically provide their customers with the ability to access and view a wide range of pre-designed product templates, select a desired template, and enter information to create a customized product design. Typically, a user can add, modify, and position custom text and upload images to be added to the electronic product design.

When a user is satisfied with the design of the product, the user can place an order with the printing service provider for the production of a desired quantity of high quality printed versions of the product to be delivered to the customer's home or business.

23. Furthermore, a skilled artisan would recognize that the materials to be used for commonly include two sides, since there are usually two sides available for printing, and would recognize the advantages in printing on both sides including, for example, the ability to provide more information to a customer through one piece of printed material.

### **Conclusion**

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

25. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**26. Any inquiry concerning this communication or earlier communications from the examiner should be:**

directed to: Dr. Hugh Jones telephone number (571) 272-3781,

Monday-Thursday 0830 to 0700 ET,

**or**

the examiner's supervisor, Kamini Shah, telephone number (571) 272-2279.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, telephone number (703) 305-3900.

**mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

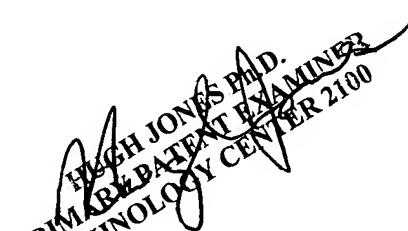
(703) 308-9051 (for formal communications intended for entry)

**or** (703) 308-1396 (for informal or draft communications, please label *PROPOSED* or *DRAFT*).

/Hugh Jones/

Primary Patent Examiner

September 1, 2007

  
HUGH JONES PH.D.  
PRIMARY PATENT EXAMINER  
TECHNOLOGY CENTER 2100